

REMARKS

I. Claim Changes

New claims 19 to 27 have been added, while claims 10 to 18 have been canceled.

The new claims 19 to 27 correspond to and contain substantially the same subject matter as claims 10 to 18 respectively, **except that the new main colorant claim 19 and compound claim 27 include additional features and limitations** to distinguish them from the cited prior art.

In addition, formal changes have been made in the wording of all the claims to provide a wording that is clearer more definite and more distinctly points out the claimed invention in relation to the prior art.

II. Claims containing Allowable Subject Matter

Claims 12 to 15 were objected to as dependent on a rejected base claim, but would be allowable if rewritten in independent form to include all limitations of the base claim and any intervening claims. See paragraph 8 on page 5 of the Office Action.

Claims 21 to 24 contain substantially the same subject matter as claims 12 to 15 respectively. Each of these claims has been amended as directed so that it is an independent claim containing the allowable subject matter.

For the foregoing reasons allowance of claims 21 to 24 is respectively solicited.

III. Anticipation Rejection based on Braun, et al

Claims 10 to 11 and 16 to 17 were rejected under 35 U.S.C. 102 (b) as anticipated by Braun, et al (WO 99/59527)

Claims 10 to 11 and 16 to 17 have been canceled, obviating this anticipation rejection. However new claims 19, 20 and 25, 26 have been filed above with similar subject matter.

Claim 19 claims a colorant containing at least one 2-hydroxy-5-amino-biphenyl derivative compound of formula (I), but includes an additional proviso that distinguishes it patentably from the subject matter of Braun, et al.

Braun, et al, does disclose biphenyl derivatives consisting of 2,5-diamino-1-phenylbenzene derivatives. However new claim 19 includes the proviso that:

"if one of **R3** and **R6** denotes an amino group, an alkylamino group or a dialkylamino group, another of **R3** and **R6** different from said one of **R3** and **R6** does not denote an amino group, an alkylamino group or a dialkylamino group".

This proviso excludes all 2,5-diamino-1-phenylbenzene derivatives from the colorant claimed in new claim 19 and the claims that depend on it, because **R3** and **R6** are in a para relationship. Basis for this limitation is provided by the many examples in applicants' specification on page 10 and following.

For the foregoing reasons and because of the additional limitation in new claim 19, it is respectfully submitted that none of the new claims 19 to 26 should be rejected under 35 U.S.C. 102 (b) as anticipated by Braun, et al, WO 99/59527.

IV. Obviousness-type Double Patenting Rejection

Colorant claims 10,11 and 16, 17 were provisionally rejected under the judicially created doctrine of obviousness-type double patenting, as obvious over claims 1 to 4 and 6 to 12 of U.S. Patent No. 6,500,213 B1, issued to Braun, et al.

U.S. Patent 6,500,213 B1 issued on a U.S. National Stage application for the International Patent Application WO 99/59527, Braun, et al, which was used to reject canceled claims 10,11 and 16, 17 as anticipated above.

New claims 19, 20 and 25, 26 correspond to the canceled claims 10,11 and 16,17, but new claim 19 includes the additional proviso listed above to distinguish from the subject matter of Braun, et al.

It is respectfully submitted then that a terminal disclaimer should not be necessary to overcome this obviousness-type double patenting rejection based on U.S. Patent 6,500,213 B1, which contains the identical subject matter as in WO 99/59527.

Again this added limitation in new claim 19 is:

"if one of **R3** and **R6** denotes an amino group, an alkylamino group or a dialkylamino group, another of **R3** and **R6** different from said one of **R3** and **R6** does not denote an amino group, an alkylamino group or a dialkylamino group".

Because of this limitation claim 19 does not claim any N-substituted or unsubstituted 2,5-diamino-1-phenylbenzene derivatives, whose disclosure in the reference is the basis for the rejection. Basis for the added proviso is provided by

the examples in the applicants' specification on page 10 and following.

Thus double patenting is no longer an issue because the proviso completely excludes the developers of the Braun, et al, U. S. Patent from the claimed colorant. The "right to exclude" based on U.S. '213 would not be improperly extended by the issuance of a patent with new claims 19, 20 and 25, 26 in it.

For the foregoing reasons withdrawal of the rejection of claims under the judicially created doctrine of obviousness-type double patenting, as obvious over claims 1 to 4 and 6 to 12 of U.S. Patent No. 6,500,213 B1, issued to Braun, et al.

V. Anticipation Rejection of the Compound Claims based on EP 0 027 679

Claim 18 was rejected under 35 U.S.C. 102 (b) as anticipated by Edward, et al, EP 0 027 679.

Claim 18 has been canceled, but new claim 27 corresponds to the compound claim 18.

New claim 27 however contains additional provisos or limitations to distinguish it patentably from the compounds disclosed in the EP reference.

EP 0 027 679 does disclose a compound of formula VI on page 4, which is used to synthesize his claimed compounds, which does anticipate the compounds of formula I when X = H and Y = halogen. However this compound does not anticipate new claim 27 because of the following added proviso:

"if **R1** and three of the **R2, R3, R4, R5 and R6** each denote hydrogen, and one of the remaining **R2, R3, R4, R5 and R6** denotes hydrogen, a halogen atom or a C₁- to C₆-alkyl group, another of the remaining **R2, R3,**

R4, R5 and R6 does not denote a halogen atom, a cyano group, a hydroxy group, a C₁-C₄- alkoxy group, a C₁-C₄-alkylthioether group, a nitro group, an amino group, an alkyl amino group, a dialkylamino group or a trifluoromethyl group".

Because of this added proviso the compound of formula VI of the EP reference and other compounds disclosed in that reference does not anticipate any of the claimed compounds of new claim 27, because the phenyl group attached to the substituted or unsubstituted p-hydroxyphenol group in applicants' claimed compounds of formula Ia cannot have two substituents, wherein one is hydrogen, halogen or a lower alkyl and the other is halogen, trifluoromethyl, lower alkoxy, cyano, hydroxy, nitro, lower alkylthio, amino, lower alkyl amino, di(lower alkyl)amino, pyrrolidino or piperidino (these last two groups are not mentioned in the proviso, but also they are not among the possible choices for the R groups according to formula Ia).

Thus new claim 27 claims none of the compounds disclosed by Edward, et al.

For the foregoing reasons and because of the changes in the wording of the compound claim, now claim 27, it is respectfully submitted that the new claim 27 should not be rejected under 35 U.S.C. 102 (b) as anticipated by Edward, et al, EP 0 027 679.

Should the Examiner require or consider it advisable that the specification, claims and/or drawing be further amended or corrected in formal respects to put this case in condition for final allowance, then it is requested that such amendments or corrections be carried out by Examiner's Amendment and the case passed to issue. Alternatively, should the Examiner feel that a personal discussion might be helpful in advancing the case to allowance, he or she is invited to telephone the undersigned at 1-631-549 4700.

In view of the foregoing, favorable allowance is respectfully solicited.

Respectfully submitted,



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